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EXAMINER
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LIEN, TAN

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/865,013	<b>Applicant(s)</b> O'HARA ET AL.	
	<b>Examiner</b> Tan Lien	<b>Art Unit</b> 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/24/01.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 and 26-38 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-24 and 26-38 are presented for examination.

Claims 1, 12, 24, 32 and 38 are amended.

Claim 25 is canceled.

#### ***Withdrawn Rejections - 35 USC § 112***

Applicant has clarified claim 38 and Examiner withdraws 35 USC 112 (2<sup>nd</sup>) rejection to claim 38.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claims 1-5, 8-17, 20-24, 26-29, 31-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costales et al (US Patent 6,044,395) in view of Marks et al (US PGPub 2001/0054059).*

Claim(s) 1: Costales teaches a method of sending common information to multiple destination sources using a handheld computer, the method comprising:

selecting information in a source file (col. 2, lines 50-53; wherein the common content chunk is selected from a source file and sent to the multiple-destination recipients);

storing the selected information in memory (col. 2, lines 50-59; wherein the first portion of the e-mail is sent first and store in cache or memory waiting for the second portion to be reassembled);

selecting a remote destination (col. 2, lines 32-37; wherein every e-mail has a final destination);

adding a first destination-specific information to the selected information (col. 2, lines 54-57; wherein the destination-specific information is the second portion of the e-mail message containing information specific to the particular recipient);

sending the selected and the first destination-specific information to the remote destination (FIG. 3, ref. 304 & 306 and col. 2, lines 50-59; wherein the selected information is the common content chunks and the destination-specific information is the individual message specific to the recipient);

selecting a second remote destination (col. 2 lines 34-37; it's sending it to multiple recipients so there is at least a second remote destination);

adding a second destination specific-information to the selected information (col. 2, lines 54-57; wherein the second destination-specific information is the second portion of the e-mail message containing information specific to the particular recipient other than the first one sent out); and

sending the selected and the second destination-specific information to the remote destination (FIG. 3, ref. 304 & 306 and col. 2, lines 50-59; wherein the selected information is the common content chunks and the second destination-specific information is the individual message specific to the second of multiple recipients).

Costales, however, fails to teach sending destination-specific information and selected information to the remote destination in a single message.

Marks, in an analogous art, teaches delivering e-mail advertisement batched by advertising subject matter such that multiple advertising messages contained within a single e-mail transmission (p. [0010]). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of sending common information to multiple destination sources with Marks' method of batching advertising messages by subject matter in a single e-mail message, for the advantage of cost effectiveness (Abstract Marks).

Art Unit: 2141

Claim(s) 12: Costales teaches a method of customizing information contained in an electronic file using a handheld computer based on the intended recipient of the information, the method comprising:

selecting information in a first electronic document (FIG. 3 and col. 2, lines 50-53; wherein the content chunk is the first electronic document and the whole information is selected and transmitted first);

automatically generating a second electronic document (col. 2, lines 54-57; wherein the second electronic document is the first and second portion that forms a complete e-mail message, and the complete e-mail is automatically generated by inserting the content chunk into the individual message), the second electronic document including the information selected from the first electronic document (col. 2, lines 57-59);

choosing an output destination for the second electronic document (col. 2, lines 57-59; wherein each complete e-mail message has at least an output destination or recipient);

adding customized information to the second electronic document (col. 2, lines 54-59; wherein the individual message is customized information and it gets added to the common content chunk);

Art Unit: 2141

delivering the second electronic document to the output destination (col. 2, lines 33-36; wherein the complete message is assembled and delivered to the final destination);

automatically generating a third electronic document (col. 2, lines 54-57; wherein the third electronic document is the first and second portion that forms a complete e-mail message for a different recipient, and the complete e-mail is automatically generated by inserting the content chunk into the individual message), the third electronic document including the information selected from the first electronic document (col. 2, lines 57-59; wherein the first electronic document is the common chunk);

choosing an output destination for the third electronic document (col. 2, lines 57-59; wherein each complete e-mail message has at least an output destination or recipient);

adding customized information to the third electronic document (col. 2, lines 54-59; wherein the individual message is customized information and it gets added to the common content chunk); and

delivering the third electronic document to the output destination (col. 2, lines 33-36; wherein the complete message is assembled and delivered to the final destination).

Costales, however, fails to teach sending destination-specific information and selected information to the remote destination in a single message from the handheld computer.

Marks, in an analogous art, teaches delivering e-mail advertisement batched by advertising subject matter such that multiple advertising messages contained within a single e-mail transmission (paragraph. [0010]) from an audio-enable cellular telephones such as Mobile Interactive Radio. It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of sending common information to multiple destination sources with Marks' method of delivering batched advertising messages by subject matter in a single e-mail message from mobile devices, for the advantage of cost effectiveness (Abstract Marks).

Claim(s) 24, 26: Costales a method of conveying electronic information to members of a defined group using a handheld computer, the method comprising:

creating a distribution group including a plurality of recipients (col. 2, lines 33-36; wherein the multiple e-mail messages are in a distribution group);



generating a first electronic file, the file including common information to be sent to at least one of the plurality of recipients (col. 2, lines 50-53 and FIG. 3, ref. 304);

choosing a first recipient from the plurality of recipients in response to a user prompt (FIG. 5A, ref. 505 ; wherein after the "TO:" prompt the user chooses a first recipient by entering the first email address);

entering a first customized set of information in the electronic file tailored to the first recipient (col. 2, lines 54-57; wherein the second portion of the e-mail contains information specific to the first recipient);

sending the common information and the first customized set of information to the first recipient (col. 2, lines 36-37);

choosing a second customized set of information in a second electronic file tailored to the second recipient (FIG. 5A, ref. 505 ; wherein after the "TO:" prompt the user chooses a second recipient by entering the second email address);

entering a second customized set of information in a second electronic file tailored to the second recipient (col. 2, lines 54-57; wherein the second portion of the e-mail contains information specific to the second recipient); and

sending the common information and the second customized set of information to the second recipient (col. 2, lines 36-37).

Costales, however, fails to teach sending destination-specific information and selected information to the remote destination in a single message from the handheld computer.

Marks, in an analogous art, teaches delivering e-mail advertisement batched by advertising subject matter such that multiple advertising messages contained within a single e-mail transmission (paragraph. [0010]) from an audio-enable cellular telephones such as Mobile Interactive Radio. It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of sending common information to multiple destination sources with Marks' method of delivering batched advertising messages by subject matter in a single e-mail message from mobile devices, for the advantage of cost effectiveness (Abstract Marks).

Claim(s) 32, 33: Costales teaches a handheld computer, comprising:

- a processor (FIG. 2, ref. 202 and col. 3, lines 46-49);
- a display coupled to the processor (FIG. 2, ref. 216 and col. 3, lines 46-49);
- a memory coupled to the processor (col. 3, lines 46-49); and
- a program running on the processor,

the program configured to enable a user to create an electronic template document having a first set of information (col. 2, lines 50-54; wherein the e-mail message template contains the first portion of the message or the first set of information),

the program configured to automatically transfer the first set of information into at least one destination-specific document (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient),

the program enabling the entry of destination-specific information into the at least one destination-specific document (col. 2, lines 54-59).

Costales, however, fails to teach sending destination-specific information and selected information to the remote destination in a single message.

Marks, in an analogous art, teaches delivering e-mail advertisement batched by advertising subject matter such that multiple advertising messages contained within a single e-mail transmission (p. [0010]). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of sending common information to multiple destination sources with Marks' method of batching advertising messages by subject matter in a single e-mail message, for the advantage of cost effectiveness (Abstract Marks).

Claim(s) 2, 13: Costales teaches the method as claimed, further comprising creating a customizable file and automatically moving the selected information from the memory to the customizable file (col. 4, lines 40-44; wherein the server inserts or automatically moves the common chunk message from cache or memory into the individual messages).

Claim(s) 3, 14: Costales teaches the method as claimed, wherein the source file is an electronic mail message created by the user (col. 4, lines 32-35).

Claim(s) 4, 15: Costales teaches the method as claimed, wherein the source file is a template (col. 2, lines 50-54; wherein the source file is an e-mail message template containing the common content chunks) and the selecting information step is performed automatically (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient).

Claim(s) 5, 17: Costales teaches the method as claimed, wherein the selected information is electronic text (FIG. 1A).

Claim(s) 8, 20: Costales teaches the method as claimed, wherein

selecting a remote destination includes entering a destination address (col. 2, lines 33-36; wherein the system or user has to enter the e-mail address in order for it to be routed to the final destination).

Claim(s) 9, 21: Costales teaches the method as claimed, wherein

selecting a destination further comprises selecting the destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 10, 22: Costales teaches the method as claimed, wherein selecting a destination comprises

creating a group of destination addresses having a group name and selecting the group name (FIG. 3, ref. 304; wherein the common content chunks are transmitted to a group of destination addresses group by a group name selected by the sender).

Claim(s) 11, 23: Costales teaches the method as claimed, wherein

selecting a destination further comprises selecting the destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt

Art Unit: 2141

automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 16: Costales teaches the method as claimed, wherein

the first electronic document is a text document (FIG. 5A and 5B; wherein the first electronic document is the content chunk in the form of text).

Claim(s) 27: Costales teaches the method as claimed, wherein

the first and second electronic files are electronic mail messages (col. 2, lines 50-57 and col. 4, lines 32-35).

Claim(s) 28: Costales teaches the method as claimed, wherein

the first and second electronic files are text document files (FIG. 5A and 5B; wherein the first electronic document is the content chunk in the form of text and the second electronic file is the individual message in the form of text).

Claim(s) 29: Costales teaches the method as claimed, wherein

the common information includes electronic text (col. 2, lines 34-37 and FIG. 5A & 5B).

Claim(s) 31: Costales teaches the method of claim 24, wherein

the first customized set of information includes electronic text (col. 2, lines 54-59 and FIG. 5A & 5B).

Claim(s) 34: Costales teaches the handheld computer of claim 32, wherein

the first set of information includes electronic text (FIG. 5A and 5B).

Claim(s) 37: Costales teaches the handheld computer of claim 32, wherein

the program is further configured to enable a user to send the destination-specific document to a remote location (col. 2, lines 54-57; wherein the destination-specific document is the second portion of the information and the remote location is another computer shown in FIG. 2, ref. 206).

*Claims 6, 7, 18, 19, 30, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costales in view of Marks and Beck et al (US Patent 5,903,723).*

Claim(s) 6, 7, 18, 19: Costales teaches the method as claimed, but fails to teach

the selected information is an electronic file attachment.

Beck, in an analogous art, teaches selecting the e-mail attachments, such as a word processing file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the

Art Unit: 2141

art at the time of the invention to combine Costales' method of sending common information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claim(s) 30: Costales teaches the method as claimed, but fails to teach

the common information includes at least one electronic file attachment, and the file attachment is at least one of an audio file, video file, a spreadsheet file, a database file, a presentation file, and a text document file.

Beck, in an analogous art, teaches including the e-mail attachments in the message, such as a word processing file or text document file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of customizing information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claim(s) 35, 36: Costales teaches the handheld computer as claimed, but fails to teach



Art Unit: 2141

the first set of information includes an electronic file, and the electronic file is at least one of an audio file, video file, a spreadsheet file, a database file, a presentation file, and a text document file.

Beck, in an analogous art, teaches including the e-mail attachments in the message, such as a word processing file or text document file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of customizing information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

*Claims 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costales in view of Marks and Siitonen et al (US Patent 6,049,796).*

Claim(s) 38: Costales teaches the handheld computer as claimed, but fails to teach the remote location is another handheld computer.

Siitonen, in an analogous art, teaches a PDA using an E-mail application (Abstract and FIG. 5B of Siitonen). It would be obvious to one of ordinary skill in the art at the time of the invention to combine and use Costales' e-mail system with Siitonen's PDA, for the advantage of portability (Abstract).

***Response to Amendment***

Applicant's arguments filed 12/16/2004 have been fully considered but they are not persuasive.

In the Remarks,

(a) Applicant states that the amended, independent claims overcome anticipated Costales' teachings.

As to point (a), the amended, independent claims have overcome Costales' teachings, but the combination of Costales' teachings and suggestions, and Marks' teaching render the amended, independent claims obvious as explained in the rejections above.

(b) Applicant states that the combination of Costales in view of Beck et al does not provide a suggestion for the deficiencies of Costales and thus have no logical connection.

As to point (b), both Costales' teachings and Beck's teachings are in the same identical field specifically in the e-mail field. The advantages to combine are stated in the claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Lien whose telephone number is (703) 305-6018. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for this Group is (703) 305-3718.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [tan.lien@uspto.gov].

Art Unit: 2141

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



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SUPERVISORY PATENT EXAMINER